

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated July 31, 2006 (hereinafter Office Action) have been considered. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses the §102(e) rejection of independent Claim 11 because the Examiner has not shown where U.S. Publication No. 2004/0203610 by Deeds (hereinafter “Deeds”) teaches each of the limitations of the claimed invention. For example, the Examiner has not shown where Deeds teaches that the electronic message is one of a digital image or drawing created by means of a camera or a touch pad coupled to the terminal, a digital sound recording, a digital representation of sound, a file, data inputted over a serial data interface, material inputted to the terminal from a device external to the terminal. The cited portions of Deeds appear to discuss only a text message. Without acquiescing to characterizations of the asserted art, Applicant’s claimed subject matter, or to the applications of the asserted art or combinations thereof to Applicant’s claimed subject matter, and in an effort to facilitate prosecution, Applicant has amended Claim 11 to delete the term “a file” from the possible formats of the claimed electronic message. Deeds does not teach receiving a shorthand for a destination of an electronic message of the formats claimed. Thus, Deeds does not appear to correspond to the claimed invention, and the rejection is improper. Applicant accordingly requests that the rejection of Claim 11 be withdrawn.

Claims 14 and 19 have been amended to correspond to the limitations of Claim 11. For example, Claim 19 has been amended to include the limitations of Claim 26 (and Claim 26 has been canceled). Thus, these changes do not introduce new matter and each of these claims is believed to be patentable over Deeds for the reasons discussed above in connection with Claim 11.

Applicant also traverses the §102(e) rejection of Claim 10 based on Deeds because the Examiner has not shown where Deeds teaches each of the limitations of the claimed invention. Similar to the above discussion, the cited portions of Deeds do not teach receiving a shorthand for a destination of an electronic message where the electronic message is a Multimedia Message Service message. Contrary to the Examiner’s assertion, paragraph [0026] does not

mention a MMS message. Without a presentation of correspondence to each of the claimed limitations, the §102(e) rejection is improper and Applicant accordingly requests that it be withdrawn.

Applicant also notes that Claim 13 has been canceled rendering any rejections of Claim 13 moot. The claims depending from Claim 13 have been amended to now depend from Claim 11, which is believed to be patentable for the reasons discussed above.

Dependent Claims 2-6, 9, 12, 15, 16 and 20-23 depend from independent Claims 11, 14 and 19, respectively and also stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Deeds. While Applicant does not acquiesce with the particular rejections to these dependent claims, these rejections are also improper for the reasons discussed above in connection with independent Claims 11, 14 and 19. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited reference. Therefore, the rejection of dependent Claims 2-6, 9, 12, 15, 16 and 20-23 is improper.

Claims 7, 14, 17, 19, and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,256,516 to Wagner *et al.* (hereinafter Wagner) in view of U.S. Publication No. 2004/0198354 by Pettine Jr. (hereinafter "Pettine"). Applicant traverses the rejection because the asserted references, alone or in combination, do not teach or suggest each of the claimed limitations. Each of independent Claims 7, 14 and 19 include limitations directed to receiving a shorthand for a destination of an electronic message. While the Examiner has asserted that Wagner teaches a speed-dialing function, the Examiner has not shown that Wagner teaches receiving a shorthand for a destination of an electronic message. The Examiner's further reliance on Pettine does not overcome this deficiency as the teachings of Pettine are limited to voice calls. As neither of the asserted references teaches at least these limitations, a combination of these references must also fail to correspond to the claimed invention. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper and should not be maintained.

In addition to having to show that the asserted combination of references teaches or suggests all of the claim limitations, the Examiner must show evidence of motivation to

combine these references as asserted. Applicant respectfully submits that this requirement has not been met.

The requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to combine the references is to “have a shorthand method available through touch.” This is not evidence of motivation to combine the motion detector of Pettine with the teachings of Wagner, but rather, is a generalized statement of what is asserted as being taught by Pettine. No evidence has been provided in support of the proposed combination - that a skilled artisan would have attempted to introduce Pettine’s touch screen to the teachings of Wagner.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Since neither Wagner nor Pettine teaches using shorthand for a destination of an electronic message, as discussed above, it is respectfully submitted that the teachings of Wagner and Pettine would have provided insufficient guidance for a skilled artisan having these references before him/her to make the combination suggested by the Examiner. Applicant respectfully asserts that the Examiner’s conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant’s disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

As neither Wagner nor Pettine teaches any use of a shorthand destination with electronic messages, Applicant respectfully submits that the asserted combination simply does not

contemplate the proposed combination. This piecemeal selection of elements is tantamount to mixing teachings out of context. Such a rejection is not permissible under §103. *See In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000) (proposed modification must not be made in the abstract but rather made in view of the entire teaching of the prior art).

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wagner in view of U.S. Publication No. 2004/0259591 by Grams. Applicant respectfully traverses the rejection because the cited references, alone or in combination, do not teach or suggest each of the claimed limitations. Similar to the above discussion, Wagner does not teach a processing unit configured to receive shorthand for a destination of an electronic message. The Examiner relies upon Wagner's teaching of a speed-dial function; however this reliance is misplaced as the speed-dial function of Wagner is related to voice messages and not electronic messages, as claimed. The Examiner also acknowledges that Wagner does not teach a user interface element including a motion-sensing device configured to recognize a special motion as the shorthand for the message destination. The Examiner's reliance on Grams as teaching these limitations is also misplaced because the motion detection feature of Grams is also limited to voice calls. Neither Wagner nor Grams teaches receiving shorthand for a destination of an electronic message, as claimed. As neither of the asserted references teaches at least these limitations, a combination of these references must also fail to correspond to the claimed invention. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper and should not be maintained.

Moreover, the requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to combine the references is to "have a shorthand method available through the detection of motion." This is not evidence of motivation to

combine the motion detector of Grams with the teachings of Wagner, but rather, is a generalized statement of what is asserted as being taught by Grams. No evidence has been provided in support of the proposed combination - that a skilled artisan would have attempted to introduce Grams' motion detector to the teachings of Wagner, and Applicant submits that the Examiner's conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant's disclosure. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

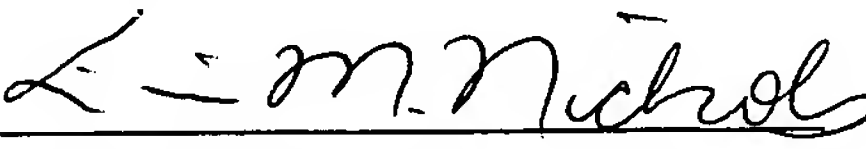
Regarding the §103(a) rejection of dependent Claims 18 and 25, Applicant respectfully traverses because the asserted combination of references does not teach each of the claimed limitations and the requisite evidence of motivation has not been presented. As discussed above in connection with independent Claims 14 and 19, Wagner, as combined with Pettine and/or Grams, does not teach receiving a shorthand for a destination of an electronic message. Thus, combining all three references cannot overcome this deficiency. Further, the requisite motivation for combining Wagner with Pettine and Grams has not been presented. Thus, a *prima facie* rejection of dependent Claims 18 and 25 has not been presented, and Applicant requests that the rejection be withdrawn.

Applicant submits that the Examiner has not shown that Deeds corresponds to the claimed invention and the asserted combinations based upon the teachings of Wagner, Pettine, and Grams also fail to correspond to the claimed invention. Moreover, the requisite evidence of motivation that a skilled artisan would have combined the references as asserted has not been presented. Applicant accordingly requests that each of the rejections be withdrawn.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.078PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,
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By: 
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